

## REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

New claims 26-29 correspond to claims 22-25, respectively, but depend from claim 20. New claims 30-33 also correspond to claims 22-25, respectively, but depend from claim 21. New claim 34 has been added. No new matter has been added.

This amendment changes and adds claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 19-34 are now pending in this application.

### **Rejections under 35 U.S.C. §§ 102 and 103**

Claims 19-21 and 25 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,506,697 to Li et al. (hereafter "Li"). Claims 22-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Li in view of U.S. Patent No. 6,176,427 to Antognini (hereafter "Antognini"). Applicants respectfully traverse these rejections for at least the following reasons.

Independent claim 19 is directed to an image forming apparatus. Claim 19 includes a reading means for reading a document and providing image data on the document as first image data, and synthesizing means for synthesizing the first image data with second image data, indicative of at least one of operating conditions which determine image quality of the reading means, an image processing means and an image forming means. Neither Li nor Antognini disclose synthesizing first image data (based on reading a document) with second image data, where the second image data is indicative of at least one of operating conditions which determine image quality of the reading means, an image processing means and an image forming means.

Li discloses a device with a page scanner 42 that reads an original document 40 containing alphanumeric text (col. 7, lines 48-50). An encoder 44 converts the alphanumeric

text into a highly compressed coded symbol 45 (col. 7, lines 50-51). The coded symbol 45 is then printed on a document 50 by a printer 46 (col. 7, lines 56-57). In addition to a content of the printed information 22a itself, the code symbol 45 may include encoded data such as application data (such as the particular software used to generate the original document text) (col. 8, lines 4-10), and data for controlling dissemination of all or portions of the content of original document (such as specifying a limited number of facsimile transmissions of the document 50 or a time limit) (col. 8, lines 19-24). The document 50 may be faxed by a transmitting facsimile machine 52 to a receiving facsimile machine 54 which prints a facsimile 56 of the original document 50, where the facsimile contains human-readable alphanumeric text 56a from the original document as well as the machine-readable facsimile symbol 56b (col. 8, lines 42-48).

While the Office Action appears to equate the code symbol 45 with the second image data as claimed, applicants submit that the code symbol 45 of Li is not indicative of at least one of operating conditions which determine image quality of a reading means, an image processing means and an image forming means, in contrast to the second image data of the claims. The code symbol 45 of Li is information, such as text, application data or data for controlling dissemination of the original document, encoded into a highly compressed symbol. Thus, while the code symbol 45 may be indicative of the alphanumeric text, or application data, or data for controlling dissemination of the original document, nowhere does Li disclose that the code symbol is indicative of at least one of operating conditions which determine image quality of a reading means, an image processing means and an image forming means, in contrast to the second image data of the claims. Thus Li fails to anticipate claim 19 for at least this reason.

Moreover, Li fails to suggest the advantages of the present invention of claim 19 where both the first and second image data are synthesized on the same sheet of paper. Specifically, the present invention of claim 19 provides important information to a user, such as a serviceperson, to aid the user in image adjustment work, an advantage not recognized or suggested by the device of Li. In the present invention of claim 19, operating condition information, which determines image quality, is additionally formed on the sheet of paper as second image data along with the first image data. This feature is not disclosed or suggested in Li. An embodiment of the present invention aids the serviceperson who repairs the image

forming apparatus by providing both the first image data as well as the second image data with information indicative of operating conditions on the same sheet of paper. As an example, in some embodiments of the invention, a serviceperson can check the operating conditions printed on a sheet of paper, as well as an image copy obtained by a scanner. In this manner, the serviceperson can reasonably determine which portion of the image forming apparatus is out of order. By contrast, the code symbol of Li is not indicative of at least one of operating conditions which determine image quality of a reading means, an image processing means and an image forming means, and the code symbol of Li is intended to be machine readable, not human readable. Thus, even if the alphanumeric text (as the asserted first image data) and code symbol of Li is formed on the same sheet of paper, the combined image would not readily aid the serviceperson in image adjustment work, since the code symbol of Li is not indicative of at least one of operating conditions which determine image quality of a reading means, an image processing means and an image forming means.

Antognini does not cure the deficiencies of Li. Antognini discloses embodiments in Figures 9 and 10 with encoded digital data in a data tile format along with graphics and text on a substrate. The Office Action appears to equate the digital encoding of Antognini with the second image data of the claims. The encoded digital data in the data tiles of Figures 9 and 10, however, as best understood, is not indicative of at least one of operating conditions which determine image quality of the graphics and text. Thus, even if there were motivation (which there is not) to combine Antognini with Li, the combination would not meet all the limitations of claim 19. The portions of the Antognini reference cited in the Office Action as disclosing the claimed operating condition image producing means refers only to parameters regarding the data tiles themselves, not to parameters regarding, for example, graphics and text.

The dependent claims, 20-34, all ultimately depend from claim 19 and are patentable for at least the same reasons, as well as for further patentable features recited therein. For example, claim 20 recites that the operating condition image producing means includes means for producing a character image data indicative of the operating conditions. This feature is neither disclosed nor suggested by Li or Antognini. New claim 34 recites that the image corresponding to the second image data is user readable. This means that a user is able to

understand and evaluate the second image data. This contrasts with the code symbol 45 of Li and data tiles of Antognini.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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